REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on June 1, 2004. A petition for a 3-month extension of time is attached so that the due date is to and including December 1, 2004. Entry of this amendment is requested.

Claims 2, 4, 6, 7, 9, 11, and 13 are rejected over Trane in view of Behl (US 6,473,297).

Pursuant to 35 U.S.C. § 103(c), Behl cannot be used to render the pending claims obvious, since Behl and the present application were owned by the same assignee at the time of filing. The American Inventors Protection Act of 1999 ("AIPA") amended 35 U.S.C. § 103(c) to add that subject matter that only qualifies as prior art under 35 U.S.C. § 102(e) and that was commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a). Specifically, § 103(c) now states:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

According to the AIPA § 4807(b), §103(c) applies to any patent application filed on or after the date of enactment, November 29, 1999. See MPEP § 706.02(l)(1), which explains the U.S.P.T.O.'s policy towards § 103(c).

Here, the present application was filed on July 5, 2000 (i.e., after November 29, 1999) so that the changes to § 103(c) made by the AIPA apply to this application. Behl issued on October 29, 2002, which is after the filing date for the present application (July 5, 2000). Accordingly, if Behl is prior art at all, it is prior art under 35 U.S.C. § 102(e).

It is believed that Behl and the present application were also commonly owned or subject to assignment to the same person, Inclose Design, Inc., at the time that the invention of

the present application was made. In this regard, the undersigned, an attorney of record believes that:

> **U.S. Patent Application No. 09/610,053 and U.S. Patent No. 6,473,297 were, at the time the invention of U.S. Patent Application No. 09/610,053 was made, owned by Inclose Design, Inc. of San Jose, California or subject to an obligation of assignment Inclose Design, Inc.**

In sum, because Behl is only prior art under 35 U.S.C. § 102(e) and because Behl and the present application were commonly assigned or subject to assignment to the same person at the time of the invention, Behl cannot be used to render the claims obvious pursuant to 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request that the pending obviousness rejection of record, which is based on Behl, be withdrawn.

In this Amendment, new claims 16-20 are also added. The closest prior art cited to date is Trane. These claims are patentable over Trane, since Trane fails to teach or suggest a television recording system comprising, *inter alia*, a carrier capable of being removeably insertable in a disk drive storage bay in a television recorder, wherein the carrier and a hard disk drive are capable of being *completely* removed from the television recorder as indicated in independent claim 16. While the Office Action indicates that component "14" is a "carrier", as explained at paragraph [0019] of Trane, component 14 is a disk drive slot for DVDs, CDs, mini-discs, and floppy disks. Component 14 is <u>not</u> a hard disk drive, and it clearly is not "completely" removable from the recording apparatus in Trane. It therefore does not teach a "hard disk drive bay". Since there is no teaching or suggestion in Trane to arrive at the invention of independent claim 16, Applicant submits that independent claim 16 and claims dependent thereon are also allowable along with the other pending claims.

Lastly, claims 2, 4, 6, 7, 9, 11, and 13 are rejected under the doctrine of obviousness double patenting at page 5 of the Office Action (in view of U.S. Patent No. 6,473,297).

Applicants submit that the claims are <u>not</u> obvious in view of Trane and Behl. As noted above, Trane fails to teach or suggest a disk drive that is "removable" from a television

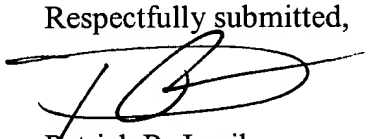
recorder as indicated in the pending claims. The hard disk drive 12 that is disclosed in Trane is clearly not removable. Behl fails to mention a television recorder at all. Accordingly, it is believed that the claims are not obvious over claims of U.S. Patent No. 6,473,297. However, to expedite the prosecution, a terminal disclaimer is being filed herewith. Withdrawal of the rejection is requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Patrick R. Jewik
Reg. No. 40,456

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
PRJ

60363698 v1